

## **REMARKS**

### **Status of the Claims**

Claims 1 and 3-27 were pending in this application—with claims 12-16 and 24-27 being withdrawn from consideration. By this response claim 1 has been amended. The amendment to claim 1 includes adding in the limitations of claim 3. Accordingly, Applicant submits that the amendments are fully supported and do not add new matter.

Moreover, in view of the amendment to claim 1, claim 3 has been cancelled. Further, claims 12-27 have been cancelled. These claims have been cancelled in an effort to expedite prosecution and the Applicant reserves its right to pursue these claims at a later time or in a continuation or divisional application.

Finally, Applicant has added new claim 28—which corresponds to original claim 2 (previously cancelled).

Accordingly, claims 1, 4-11 and 28 are now pending.

In the office action, the following objections and rejections were made:

claims 24 and 26 were rejected as not being supported by the specification;

claims 25 and 27 were rejected as containing trade names;

claims 3 and 18 were rejected as being indistinguishable;

claims 1, 3-11 and 17-23 were provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 8, 9, 12, 13, 15-17 and 24 of co-pending Application No. 11/649,728;

claims 1, 3-6, 17, 18-20 and 22 were rejected under 35 U.S.C. § 102(b) as being anticipated by Komiyama *et al.* (U.S. Patent No. 5,118,567);

claims 1, 3-8 and 17-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by Noguchi *et al.* (U.S. Patent No. 5,476,752);

claims 10 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Noguchi *et al.*;

claim 17 was rejected under 35 U.S.C. § 102(e) as being anticipated by Xu (U.S. Pat. Publication No. 2007/0149667), European Patent No. 1,086,403 and Oka *et al.* (U.S. Patent No. 6,485,885);

claims 1, 3-11 and 18-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. 1,086,403 in view of Knell (U.S. Patent No. 5,346,933) and Kamen *et al.* (U.S. Patent No. 5,656,336); and,

claims 1 and 4-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Xu (U.S. Pat. Publication No. 2007/0149667) and Oka *et al.* (U.S. Patent No. 6,485,885) in view of Knell (U.S. Patent No. 5,346,933) and Kamen *et al.* (U.S. Patent No. 5,656,336).

Applicant respectfully traverses all of the above rejections and requests reconsideration of same in light of the follow arguments and above amendments.

### **Argument**

#### **Claims 24 and 26**

In view of the above cancellation of these claims, Applicant submits that this rejection is moot.

#### **Claims 25 and 27**

In view of the above cancellation of these claims, Applicant submits that this rejection is moot.

#### **Claims 3 and 18**

Applicant submits that the amendments to claim 1 and the cancelling of the claim 3 render this rejection moot.

#### **Double Patenting Rejection**

Applicant respectfully traverses the maintained rejection of the claims in view of the co-pending application. In view of the fact that both the present claims and the claims in the co-pending application are both still in prosecution, Applicant reserves it right to address this issue in more detail should claims in either application be allowed or issued.

#### **35 U.S.C. 102(b)**

The glass printing ink or lacquer of claim 1 comprises, besides a photoinitiator:

a bisphenol A based epoxy resin;

a resin selected from the group consisting of: a melamine acrylate, an acid-modified polyester acrylate, and, an epoxy acrylate; and

a UV hardening monomer.

The term "monomer" excludes any low-molecular compounds wherein a structural entity ("repeating unit") is present repeatedly. The latter compounds are oligomers, as is well-known to a person of ordinary skill in the art. All compounds termed "monomers" which are recited in the present application are true monomers.

Komiyama *et al.* discloses an adhesive layer comprising an epoxy resin, *e.g.*, based on bisphenol A, a (meth)acrylate polymer, a photopolymerizable low molecular weight compound having at least one carbon-carbon double bond, and a photopolymerization initiator. The low molecular weight compound is characterized further in column, 4, lines 22 – 35. From there it becomes clear that the low molecular weight compound is an oligomer (this is expressly mentioned, and furthermore all compounds cited in that passage are oligomers), not a monomer. Komiyama *et al.*, therefore, fails to disclose or suggest a UV curable monomer present in the adhesive layer.

Accordingly, Applicant submits that claim 1 is patentable over Komiyama *et al.*

Noguchi *et al.* discloses an active energy ray curing resin composition comprising (i) a specified linear polymer, (ii) a monomer having an ethylenically unsaturated bond, (iii) an epoxy resin comprising at least one compound having one or more epoxy groups, which may be of the bisphenol A type (*see* column 8, lines 40-43), and a polymerization initiator capable generating a Lewis acid by irradiation with an active energy ray.

The specified linear polymer does not comprise melamine acrylate, an acid-modified polyester acrylate and/or an epoxy acrylate (*see* column 2, line 61 to column 6, line 33). Nor is there any suggestion for such a chemical to be included.

Therefore, Applicant submits that claim 1 is patentable over Noguchi *et al.*

Steinmann *et al.* discloses a photosensitive composition comprising a liquid epoxy resin (which may be bisphenol A-based), at least one OH-terminated polyether, polyester or polyurethane, a liquid diacrylate and a liquid poly(meth)acrylate, and a cationic photoinitiator for

the epoxy resin.

Steinmann *et al.* does not disclose or suggest a melamine acrylate, an acid-modified polyester acrylate and/or an epoxy acrylate.

Therefore, Applicant submits that claim 1 is patentable over Steinmann *et al.*

35 U.S.C. 103(a)

Claim 3 of the present application has been rejected as being unpatentable over European Patent No. 1,086,403 in view of Knell and Kamen (page 8, next to last paragraph of the office action).

In the first paragraph on page 9 of the office action it is conceded that a melamine acrylate, an acid-modified polyester acrylate and/or an epoxy acrylate as required by present claim 1 are not recited in the European Patent.

Knell and Kamen also fail to disclose or suggest these specific acrylate compounds. Further, Oka and Xu do not disclose or suggest these compounds. Moreover, Applicant submits that these specific acrylate compounds are not ones that would be commonly used by a person of ordinary skill in the art.

Therefore, the European Patent in view of Knell or Kamen (or in view of Oka and/or Xu) cannot render claim 1 obvious, since the specific acrylate compounds are not disclosed in any of these references nor would one of ordinary skill in the art routinely use these specific acrylate compounds in combination with a bisphenol A based epoxy resin.

In view of the above, Applicant submits that claim 1, and all of the depending claims there from, are patentable over the cited prior art.

**CONCLUSION**

In view of the above, it is submitted that the present application is in condition for issuance and a notice of allowance is respectfully solicited.

If any additional fees are required with this correspondence, the Commissioner is authorized to debit our Deposit Account 50-0545.

Should anything further be required, a telephone call to the undersigned at (312) 226-1818 is respectfully solicited.

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Respectfully Submitted,

/Patrick J. Smith/  
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One of the Attorneys for the Applicants